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| 09/915,419 | 07/27/2001 | Hiroaki Nakazawa | 35.C15617 | 7015 |
| 5514 | 7590 | 01/26/2005 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | HADIDI, JON | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2671 | |

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/915,419 | Applicant(s) NAKAZAWA ET AL. | |
| | Examiner Jon Hadidi | Art Unit 2671 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 13, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6-10, 12-16, 18, 20-24, 26-28, 30, and 32-43 is/are rejected.
- 7) ☒ Claim(s) 3, 5, 11, 17, 19, 25, 29 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 6, 7, 9, 12, 13, 15, 16, 20, 21, 23, 27, 28, 32, 33, 35, 37, 38, and 40-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim, U.S. Publication No. US 2001/0018667.

With regard to claim 1, Kim describes generation means for generating a character (see Kim, Fig. 21, member DB 11, and paragraphs [0081 to 0082], wherein the characters or avatars are stored) capable of making a designated motion (see Kim, Fig. 14, character representations 17a and 17b, and paragraph [0071], wherein the character representations 17a and 17b are moved around the virtual three-dimensional area 12); and computation means (see Kim, Fig. 21, web server 10 and paragraph [0082]) for computing a charge for the character on the basis of the motion of the character (see Kim, paragraphs [0097] to [0100], wherein the character representation or avatar is charged based upon its movement to a grocery store, music store, or dance classroom).

With regard to claims 2 and 16 Kim describes wherein said computation means performs the computation on the basis of the amount of movement of the motion (see Kim, paragraphs [0097] to [0098], wherein the character representation or avatar is charged based upon the number of food articles selected at the virtual grocery store, and/or the number of times the user moves to the grocery store to buy items).

With regard to claims 6 and 20, Kim describes wherein said computation means performs the computation on the basis of the amount of change in the motion (see Kim, paragraphs [0097] to [0098], wherein the character representation or avatar is charged based upon the number of food articles selected at the virtual grocery store by moving the avatar to the selected items – i.e., the more change in the motion, the most grocery store items are bought).

With regard to claims 7 and 21, Kim describes wherein said computation means performs the computation on the basis of a motion mode of the motion (see Kim, paragraph [0087], wherein the motion mode is a conversation, and wherein in paragraph [0085], both users log in under an authorized use or pay system, wherein the pay system may include hourly charges, so that the computation means performs computations based on the time the two users speak to each other via their avatars).

With regard to claim 12, Kim describes wherein the character is encrypted and the user-side apparatus has information for decrypting the character (see Kim, paragraphs [0084] to [0085], wherein the character or avatar is initially encrypted -- wherein encryption is the process of obscuring information to make it unreadable without special knowledge or the proper mechanism to decrypt it -- until the user, using

user using user-side apparatus 15, provides proper authentication to decrypt and thereby have access to the avatar).

With regard to claim 13, Kim describes wherein access to the character is restricted and the user-side apparatus has authentication information for enabling access to the character (see Kim, paragraphs [0084] to [0085], wherein access to a desired avatar is restricted, and the client computer 15 has authentication information entered into it by a user of the client computer to enable access to the avatar).

With regard to claim 15, Kim describes receiving means for receiving information designating a motion of the character (see Kim, Fig. 21, Web site 14, and paragraphs [0081] and [0082], wherein the user inputs character movement information into web site 14 via client computers 15); and computation means (see Kim, Fig. 21, web server 10 and paragraph [0082]) for computing a charge for the character on the basis of the motion of the character (see Kim, Fig. 14, character representations 17a and 17b, and paragraph [0071], wherein the character representations 17a and 17b are moved around the virtual three-dimensional area 12. Furthermore, see Kim, paragraphs [0097] to [0100], wherein the character representation or avatar is charged based upon its movement to a grocery store, music store, or dance classroom).

With regard to claim 27, Kim describes designation means for designating a motion of the character (see Kim, Fig. 21, Web site 14, Client computers 15, and paragraphs [0081] and [0082], wherein the user designates character movement information to Web site 14 via Client computers 15); and display means for displaying the character moving on the basis of the designation by said designation means (see

Kim, paragraph [0092], wherein the user's moving character or avatar is displayed on a computer monitor which is part of Client computers 15).

With regard to claim 28, Kim describes wherein said designation means designates an amount of movement of the motion (see Kim, Fig. 21, Web site 14, Client computers 15, and paragraphs [0081] and [0082], wherein the user designates an amount of character movement using client computer 15).

With regard to claim 32, Kim describes wherein said designation means designates an amount of change in the motion (see Kim, Fig. 21, Web site 14, Client computers 15, and paragraphs [0081] and [0082], wherein the user designates movement of an alter ego character using client computer 15 connected to Web site 14).

With regard to claim 33, Kim describes wherein said designation means designates a motion mode of the motion (see Kim, paragraph [0087], wherein the motion mode is a conversation, and wherein the conversation requires motion because the avatars must move next to each other before the conversation can be initiated).

With regard to claims 9, 23, 35, Kim describes wherein the motion mode relates to a kind of method for a conversation held by the character (see Kim, paragraph [0087], wherein the motion mode is a conversation).

With regard to claim 37, Kim describes wherein the character is encrypted and said apparatus has information for decrypting the character (see Kim, paragraphs [0084] to [0085], wherein the character or avatar is initially encrypted -- wherein encryption is the process of obscuring information to make it unreadable without special

knowledge or the proper mechanism to decrypt it -- until the user, using user computer apparatus 15, provides proper authentication to decrypt and thereby have access to the avatar).

With regard to claim 38, Kim describes wherein access to the character is restricted and said apparatus has authentication information for enabling access to the character (see Kim, paragraphs [0084] to [0085]).

With regard to claims 40 and 42, Kim describes receiving information designating a motion of the character (see Kim, Fig. 21, Web site 14, Client computers 15, and paragraphs [0081] and [0082], wherein Web site 14 receives information designating a motion of the character from Client computers 15); and computing a charge for the character on the basis of the motion of the character (see Kim, paragraphs [0097] to [0100], wherein the character representation or avatar is charged based upon its movement to a grocery store, music store, or dance classroom).

With regard to claims 41 and 43, Kim describes designating a motion of the character (see Kim, Fig. 21, Web site 14, Client computers 15, and paragraphs [0081] and [0082], wherein the user designates character movement information to Web site 14 via Client computers 15); and displaying the character moving on the basis of the designation in said designation step (see Kim, paragraph [0092], wherein the user's moving character or avatar is displayed on a computer monitor which is part of Client computers 15).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 8, 10, 14, 18, 22, 24, 26, 30, 34, 36, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim, U.S. Publication No. US 2001/0018667, in view of Taliercio, U.S. Publication No. 2002/0143622.

With regard to claim 4, Kim is relied upon for describing all of the limitations of parent claim 1, as described in the 102(e) rejection above. Kim fails to explicitly describe wherein said computation means performs the computation on the basis of the period of time during which the motion is continued, as recited in claim 4. However, Taliercio teaches all of the limitations of claim 4 (see Taliercio, paragraph [0026]).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Kim to incorporate the time-based avatar usage payment system of Taliercio, because some users may only want to try out an avatar for an inexpensive limited period of time before deciding to pay a higher flat monthly avatar fee.

With regard to claims 8, 22, 34, Kim is relied upon for describing all of the limitations of parent claims 7, 21, and 33, respectively, as described in the 102(e) rejection above. Kim fails to explicitly describe wherein the motion mode relates to a kind of expression of the character, as recited in claims 8, 22, and 34. However, Taliercio teaches all of the limitations of claims 8, 22, and 34 (see Taliercio, paragraph

[0025], wherein a sponsor buys a three-dimensional avatar representing a well-known individual or celebrity, and wherein that celebrity has unique kinds of facial expressions as captured by the method of Taliercio in paragraphs [0020] to [0022]).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Kim to incorporate the character expressions of Taliercio, because Kim fails to describe its avatars as having such character expressions, and such character expressions allow for more realistic avatars and avatars that can be based on actual people. Motivation for such a combination may be found, for example, in Taliercio, paragraph [0019].

With regard to claims 10, 24, 36, the Kim/Taliercio combination teaches wherein the motion mode relates to a kind of personality of the character (see Taliercio, paragraphs [0004] and [0025], wherein well-known individuals and celebrities who promote products for sponsors have different kinds of personalities).

With regard to claims 14, 26, 39, Kim is relied upon for describing all of the limitations of parent claims 1, 15, and 27, respectively, as described in the 102(e) rejection above. Kim fails to explicitly describe wherein the character is generated and moved by processing character data formed from a plurality of images by executing a character display/control program, as recited in claims 14, 26, and 39. However, Taliercio teaches all of the limitations of claims 14, 26, and 39 (see Taliercio, paragraphs [0018] to [0022]).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Kim to incorporate the animated avatars of Taliercio,

because Kim fails to describe animated avatars, and such character animated avatars allow for more realistic avatars and avatars that can be based on actual people.

Motivation for such a combination may be found, for example, in Taliercio, paragraph [0019].

With regard to claim 18, Kim is relied upon for describing all of the limitations of parent claim 15, as described in the 102(e) rejection above. Kim fails to explicitly describe wherein said computation means performs the computation on the basis of the period of times during which the motion is continued, as recited in claim 18. However, Taliercio teaches all of the limitations of claim 18 (see Taliercio, paragraph [0026], and paragraph [0005], which specifies that the avatars move when displayed).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Kim to incorporate the time-based avatar usage payment system of Taliercio, because some users may only want to try out an avatar for an inexpensive limited period of time before deciding to pay a higher flat monthly avatar fee.

With regard to claim 30, Kim is relied upon for describing all of the limitations of parent claim 27, as described in the 102(e) rejection above. Kim fails to explicitly describe wherein said designation means designates a period of time during which the motion is to be continued. However, Taliercio teaches all of the limitations of claim 18 (see Taliercio, paragraph [0026] , and paragraph [0005], which specifies that the avatars move when displayed).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Kim to incorporate the time-based avatar usage payment system of Taliercio, because some users may only want to try out an avatar for an inexpensive limited period of time before deciding to pay a higher flat monthly avatar fee.

Allowable Subject Matter

Claims 3, 5, 11, 17, 19, 25, 29, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With regard to claim 3, the claim language “wherein the amount of movement is the number of frames in which a moving image of the character is displayed”, in combination with the claim limitations of its parent claim(s), contains allowable subject matter.

With regard to claims 5 and 19, the claim language “wherein said computation means performs the computation on the basis of the number of parts moved in the motion”, in combination with the claim limitations of its parent claim(s), contains allowable subject matter.

With regard to claims 11 and 25, the claim language “measuring means for measuring the motion of the character, wherein said computation means performs the computation on the basis of the measured motion of the character”, in combination with the claim limitations of its parent claim(s), contains allowable subject matter.

With regard to claims 17 and 29, the claim language “wherein the amount of movement is the number of frames in which a moving image of the character is displayed”, in combination with the claim limitations of its parent claim(s), contains allowable subject matter.

With regard to claim 31, the claim language “wherein said designation means designates the number of parts moved in the motion”, in combination with the claim limitations of its parent claim(s), contains allowable subject matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon Hadidi whose telephone number is 703-605-1187. The examiner can normally be reached on M-F 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Zimmerman can be reached on 703-305-9798. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/915,419
Art Unit: 2671

Page 12

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